

REMARKS/ARGUMENTS

Applicant responds herein to the Office Action dated June 3, 2004.

The specification has been objected to and claims 1-29, 34-43 and 46-57 have been rejected under the first paragraph of 35 U.S.C. § 112, vis-à-vis 35 U.S.C. §132, which stipulates that no new matter may be entered by way of amendment.

Reconsideration is requested.

A careful reading of the originally submitted specification and focusing, for example, on pages 8 and 9 clearly establishes that the invention is not directed to the well-known license manager or to licensing controllers which are, per se, well-known in the art and which constitute executory type software which controls access to licensed software. The Office Action mentions in several instances the expedient of taking “official notice” of well established facts in the industry. While the Applicant does not necessarily agree that taking official notice is appropriate with respect to specific claimed elements that are not shown in the prior art of record, it is nonetheless correct that license managers and software products are interrelated and very well known. License managers control access to software products.

The type of license information data that is described in the instant specification is clearly non-executory, which clearly indicates that it is not related to the execution of the software, per se. Rather, the information is tangentially related to the software products that might be installed on a given computer system. This is information that is useful to know but not directly used in the form presented for software accessing and execution purposes.

Regardless, 35 U.S.C. §112 does not require that words appearing in claims be identically presented in the specification. See *In re Wright*, 9 U.S.P.Q. 2nd 1649 (Fed. Cir. 1989). Also relevant on this point is *In re Herschler* 208 U.S.P.Q. 711, 717 (C.C.P.A. 9079) which states:

The claimed subject matter need not be described *in haec verba* to satisfy the description requirement. [citation omitted]

It is not necessary that the application described the claim limitation exactly, but only so clearly that one having ordinary skill in the pertinent art would recognize from the disclosure that appellants invented processes including those limitations. [citations omitted]

Indeed, independent claim 1 commences with: “A knowledge based facility...”, which is a store of data, not executing software.

The present invention is directed to a store of information of a first type which is located in the first database and information of another type which is located in another database, and a facility which allows the two data record types to be correlated with one another. In the context of the present invention, reciting in the claims that the agreement data relates to “non-execution related information” is fully supported in the specification, including by examples of the type of data that is provided and by a description which clearly shows that the present invention does not constitute a license controller for software that is utilized on the computer, but rather to a knowledge database and to a system for the handling of the information.

In view of the foregoing remarks, the Applicant respectfully requests that the Examiner reconsider and rescind the objection to the specification and the claims including under 35 U.S.C. §112, first paragraph, and 35 U.S.C. §132. Indeed, it is worth noting that the term “non-executable data” is so clear and self-interpreting that the Office Action itself utilizes that phrase in the rejection of several of the claims on the merits. For example, see the last line on page 4 of the Office Action.

Substantively claims 1-8, 10, 12, 14-25, 27, 28, 34-41, 48 and 56 stand rejected on grounds of anticipation by Franklin (6,105,069). Further, claims 9 and 29 stand rejected under grounds of obviousness over Franklin. Still further, claims 11, 13, 26, 46, 47, 50-52, 54 and 55 stand rejected on the grounds of obviousness over Franklin, in view of Mangat (6,049,799). Claims 42 and 43 are being rejected for obviousness over Franklin and Todd (5,867,714). Claims 49 and 53 are being rejected for obviousness over Franklin and Todd, in further view of Elmasri “Fundamentals of Database Design”. Lastly, claim 57 is being rejected on the grounds of obviousness over Franklin, in view of Melchione (5,930,764). It is also noted that the rejection of claims 1-29, 34-43 and 46-57 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 15 and 22 of co-pending application No. 09/732,386, in view of the aforementioned references has been repeated. Reconsideration is requested in view of the following remarks.

The primary Franklin reference is essentially directed to a license manager. Its title “Licensing Controller Using Network Directory Services” describes its basic functionality.

To further underscore and remove even a shred of ambiguity that the present invention is not a license manager, the applicant has now amended claim 1 by reciting “a non-license manager type

knowledge base facility". Clearly the present claims are not directed to any system wherein the system itself constitutes the license manager as in Franklin, et. al.

The Office Action does not assert that Franklin, et. al. is a knowledge base and information handling system as the present invention. It is for this reason that the Office Action mentions at the bottom of page 4 of the Office Action, "some of the data in the objects may be non-functional descriptive text fields which are non-executable." Ignoring that the Office Action should not hypothesize as to what "may be", it is important to note that virtually every license manager is inherently viewable as including at least some "non-functional" descriptive text fields. For example, license managers may have fields that identify individuals who would be permitted access to a particular piece of software. That information can be "deemed" to be both executable as well as non-executable, in the sense that it describes license terms and agreement information.

But the present claims differ fundamentally from the prior art because they are not related to a license manager. The system per se is not a license manager. The Franklin reference which is relied upon as the primary reference for the rejection of each and every one of the independent claims in the application is at heart a license manager and as such is inapplicable to the instant claims. Therefore, each of the independent claims in the application and each of the dependent claims which imposes and includes limitations which are more specific than those that are found in the independent claims is submitted to be patentable over the prior art over record.

Accordingly, the Examiner is respectfully requested to reconsider the application, allow the claims as amended and pass this case to issue.

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as First Class Mail in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on August 10, 2004:

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Respectfully submitted,

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